

statement pursuant to 37 C.F.R § 1.97(c). Applicants, pursuant to M.P.E.P § 706.07 (a), therefore request the Examiner to withdraw the Final Rejection of June 4, and redesignate it as a non-final rejection

#### The Non-Priority PCT Applications

The Examiner indicates on page 2, paragraph 2 of the Office Action he no longer relies on the “non-priority” PCT applications, PCT/US 92/10872 and PCT/US 92/10874 as part of the prosecution history that bears on the present application, and which the Examiner previously looked to regarding the recapture issue. Even though the Examiner withdraws the rejection based on the “non-priority” PCT applications because he has “no adjudicated finding” (June 4, 2002 Office Action, p. 2, par. 2) to support it, applicants maintain their traverse of this aspect of the recapture rejection for reasons previously submitted in the prosecution of this application, which applicants incorporate herein by reference.

#### The Rejection Under 35 U.S.C. § 103(a) and Traverse

The Examiner rejects claims 28-32 under 35 U.S.C. §103(a) as unpatentable over Lagendijk in view of Gordon. Applicants traverse the rejection and request further consideration and reexamination.

The Examiner, in referring to Example 4 of Lagendijk, argues the disclosed CVD source of “TMCTS (a silicon oxide precursor), trimethylphosphite and an oxygen source” exemplify the prior art, with the difference “between the prior art and the instant claims . . [being] the inclusion of a metal oxide other than silicon oxide.” June 4, 2002 Office Action, p. 2, last par.). The Examiner then cites “claims 4-14” of Gordon showing various metal oxide and silicon oxide precursors to support his argument that the skilled

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artisan would combine the teachings of Gordon with Lagendijk to come up with applicants' invention of using an accelerant such as a phosphite in combination with a metal oxide precursor in a CVD coating process.

In the first instance, the teaching by Lagendijk of a phosphite with a silicon oxide precursor would not suggest to the skilled artisan the use of a phosphite with a metal oxide precursor in a CVD coating process since silicon is not a metal as the Examiner contends. Secondly, claims 4-14 of Gordon do not relate to the various metal oxide-silicon oxide precursors the Examiner describes. If, however the Examiner intended "examples 4-14" which show metal oxide-silicon oxide precursors, the skilled artisan still would not find any motivation to combine that teaching with Lagendijk, again, because Lagendijk used the phosphite with a non-metal, viz. silicon, in a CVD coating process. Lastly, Lagendijk does not disclose the phosphite of Example 4 as an "accelerant," but rather as a "dopant." The Examiner has not shown why a skilled artisan looking for an accelerant for a CVD coating process would combine the dopant teachings of Gordon with Lagendijk.

Rejected claims 28-32 require an accelerant based on either an organic phosphite, organic borate or water which the Gordon reference neither teaches nor suggests. In fact, Gordon teaches the undesirability of water, cautioning against it in example 2, which shows water causes an undesirable reaction with an organoaluminum compound, e. g., (aluminum-2, 4-pentanedionate).

In view of the Example 2 disclosure of Gordon, the skilled artisan would have an additional reason for not combining the teachings of Gordon with Lagendijk. The adverse results with water would suggest to a skilled artisan that disclosure of ancillary

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compounds in CVD coating processes in this art would not carry the implication that they would benefit any coating process, but rather, each candidate for evaluation as an adjuvant would require separate testing before they could draw any conclusion about its suitability in the process. The example 2 results of Gordon eliminate any motivation for the skilled artisan to combine the teachings of the two references. Cf., M.P.E.P. Section 2143.01, Rev. 1, Feb. 2000, pp. 2100-98 to 2100-99 and cases cited therein. Gordon, in fact, teaches against this combination of references.

Applicants do not claim that the prior art does not describe processes such as CVD oxidation to obtain oxide coatings, but rather applicants' use of unobvious starting materials in the process amounts to a patentable invention, as the Court of Appeals for the Federal Circuit decided in In re Ochiai, 77 F.3d 422, 37 U.S.P.Q. 1127 (Fed.Cir. 1995), i.e., the unobvious starting materials lend patentability to the claims.

#### The Rejection Under 35 U.S.C. § 251 And Traverse

The Examiner rejected claims 28-32 under 35 U.S.C. § 251 as improperly recapturing broadened claim subject matter surrendered in the application for the patent (the "reissue patent" Russo et al., U.S. Patent No. 5, 401, 305) which forms the basis for the present reissue application. Applicants traverse the rejection and request further consideration and reexamination.

In the paragraph immediately preceding the Examiner's rejection of the claims under 35 U.S.C. § 103 the Examiner stated "[t]he issue of recapture with respect to the new categories of invention (see M.P.E.P. § 1412.03) filed with the reissue need not be resolved unless those claims are limited to the particular precursor compositions of the patented claims." (June 4, 2002 Office Action, p. 2, par. 3). Applicants believe this part

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of the Office Action referred to the recapture issue the Examiner subsequently raised, and in order to address it, will summarize the claims as follows in order to analyze this position taken by the Examiner.

The reissue patent contains claims 1-27 directed to a process for manufacturing an oxide composition by oxidizing a silicon oxide precursor and a tin oxide precursor in the presence of an accelerant. Reissue claims 28-32 also relate to a process for manufacturing an oxide, describing the oxide generally as a metal oxide, and in subsequent claims, manufacturing the oxide from specific metal oxide precursors, the option of including a silicon oxide precursor in the process, but in all instances, the inclusion of an accelerant.

Applicants point out M.P.E.P. § 1412.03 referred to by the Examiner does not relate to issues of recapture but rather criteria for determining whether applicants have submitted broadened reissue claims. The new categories of invention as set out in claims 28-32 meet these criteria of broadened reissue claims since they include "subject matter not covered by the patent claims." (M.P.E.P. § 1412.03, p.1400-16, August 2001).

The Examiner then rejected 28-32 on grounds of improper recapture of broadened claim subject matter surrendered in the reissue patent, but did not articulate how or where applicants surrendered this broadened claimed subject matter. He also cited three decisions of the Court of Appeals for the Federal Circuit to support his recapture argument, however, did not show how those cases applied to the facts or claims of the present application, other than to conclude claims 28-32 allegedly recaptured subject matter applicants surrendered in the prosecution of the reissue

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patent. (June 4, 2002 Office Action, p. 2, first full par.)

For Example, the Examiner cited Hester Industries, Inc. v. Stein, Inc., 142 F. 3d 1472, 46 U.S.P.Q. 2d 1641 (Fed. Cir. 1998) which held that arguments made during the prosecution of an application to distinguish features of the prior art prevented the applicant from claiming those features in a reissue patent, but he has not identified any arguments applicants made in the prosecution of the reissue patent that bear on the claims of the reissue application.

The other two cited cases, In re Clement, 131 F. 3d 1464, 45 U.S.P.Q. 2d 1161 (Fed. Cir. 1997, and Ball Corp. v. United States 729 F. 2d 1429, 1436, 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984) generally stand for the proposition that a reissue applicant cannot recapture subject matter given up in a parent application in response to a prior art rejection in order to obtain allowance. The Examiner, however, has not shown where the applicants gave up subject matter by amending the reissue patent in response to a prior art rejection and now try to recapture it in this reissue application. The amendments in the reissue patent addressing the silicon oxide precursor rejection did not apply to the new category of metal oxide precursors presented in the reissue claims, since the Examiner did not reject the metal claims in the reissue patent. Applicants also point out that any statements about silicon in the reissue patent prosecution did not carry over to the metals since silicon is not a metal.

The principle that controls the prosecution of the present reissue application, however, holds that where the prosecution history shows that prior art did not motivate an amendment, and the record does not show that the patentee's conduct amounts to an admission that the reissue claims would not be patentable without the specific

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limitations of an amendment, recapture does not apply. A claim amendment responsive to an indefiniteness rejection and not a prior art rejection precludes application of the recapture doctrine based on deliberate surrender. In re Wesseler, 367 F. 2d 838, 847, 151 U.S.P.Q. 339, 346-47 (C.C.P.A. 1966). The court in Wesseler found that an indefiniteness rejection led to the inclusion of an element in the claims by amendment, not a rejection over prior art, even though the Examiner made a prior art rejection. The court ruled that in the absence of facts showing that the inclusion of the omitted limitations was required to avoid the prior art, the recapture principle of deliberate surrender based on the Supreme Court's prosecution history estoppel analysis in Shepard v. Carrigan, 116 U.S. 593, 597, 6 S. Ct. 493, 495 29 L.Ed. 723 (1886), was not applicable. The court stated:

Here, however, there is no objection to the appealed [reissue] claims based on prior art. We do not think the statement in Shepard, arising from the facts therein stated, is applicable here. Shepard may be support for the rule that one who deliberately adds a limitation to avoid the prior art cannot omit that limitation in reissue claims so as to encroach upon the prior art, but that is not the situation here . . .

*Id.* 367 F. 2d at 849, 151 U.S.P.Q. at 348 (emphasis added). In view of other portions of the prosecution history showing that the patentee did not intend to abandon coverage of its invention without the omitted limitation, the court concluded the applicants could correct the error by reissue, indicating:

the record established that the appellant erroneously considered he was securing protection commensurate with the invention disclosed in the original application. There is no evidence that appellant intentionally omitted or abandoned the claimed subject matter. We find that while appellant acted "deliberately" he did so in error. This error, in view of the facts of record, was an 'error without any deceptive intention' which entitles appellant to secure a reissue of his patent under the provisions of section 251.

*Id.* 367 F. 2d at 850, 151 U.S.P.Q. at 349 (emphasis in original).

Finally, the Wesseler court also noted that a "deliberate" amendment to create a recapture type estoppel did not arise just because an applicant submitted a written amendment to further prosecution. "Deliberate" requires that the patentee knowingly, without error, made the amendment ("every paper formally submitted is generally done 'deliberately' and with the design of advancing the prosecution so as to secure a patent. . . . [T]hat is not what is meant by the term 'deliberate.'") In re Wesseler, 367 F. 2d at 848, 151 U.S.P.Q., at 347) The court reversed the rejection of the reissue claims that omitted a limitation added to an original claim where the prosecution record did not clearly show that the patentee had "deliberately" included the limitation to avoid prior art but that the patentee had intended to claim his invention commensurate in scope with what he disclosed.

A review of the prosecution history of the reissue patent shows that the Examiner rejected the claims under 35 U.S.C. § 112, but did not reject any of the claims based on prior art, and applicants never cancelled any subject matter in the claims in response to the rejection. Applicants emphasize the new category of invention covered by claims 28-32 all relate to a process which they never claimed in the reissue patent. The present reissue application presents claims of this type for the first time in the prosecution of this aspect of applicants' invention. The Examiner never rejected these claims in the reissue patent; applicants never amended them in the reissue patent, and never cancelled them from the reissue patent. Wesseler therefore controls the prosecution of the present application, freeing it from the recapture doctrine, and allowing applicants to claim the process without the silicon oxide precursor amendments of the reissue patent.

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The Examiner nonetheless compares the process claims of the present reissue application to the composition claims presented in the reissue patent, and the amendments applicants made to those composition claims to respond to a 35 U.S.C. § 112 first paragraph rejection. The Examiner cannot look to those amendments of the composition of matter claims in the reissue patent, (one statutory class of invention) and conclude applicants gave up rights to process claims in the reissue application (a different statutory class of invention) by the reissue patent prosecution since they comprise different statutory classes of inventions. Different statutory classes of invention are separate inventions. Studiengesellschaft Kohle mbH v. Northern Petrochemical Company, 784 F.2d 351, 228 U.S.P.Q. 837, 839 (Fed. Cir. 1986). They differ in that infringement of one type of claim doesn't carry any presumption of infringement of the other. Prosecution of the reissue patent composition claims therefore has no bearing on the process claims of the present application.

The Examiner, however, argues the instant claims contain subject matter broader than the reissue patent claims in that they do not include the "rate of deposition greater than 350Å/sec." recited in the reissue patent claims. Applicants point out the invention does not relate only to improving coating speeds, but to "producing an improved coating" that exhibits "specific properties such as, e.g., controlled refractive index, abrasion resistance, color enhancement, low emissivity, selective light filtration, and anti-iridescence . . . ." (Written description, col. 4, lines 16-18) The Examiner has not shown where in the disclosure applicants obtained these "improved coating" features by applying the coating at a rate of 350Å/sec., nor can he, since applicants obtain these advantages in producing the coating or film itself, and not by the method of improving

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production speeds.

Applicants never stated the process of obtaining the "improved coating" with controlled refractive index, abrasion resistance, color enhancement, low emissivity, selective light filtration, and anti-iridescence depended on the deposition rates the Examiner employs in his rejection. The written description supports the applicants in this regard by describing the "invention . . . [as] a gaseous composition for producing an improved coating on glass . . ." (written description col. 4, lines 13 et seq.). Although this part of the written description describes a process for "producing" this coating on glass by a CVD rate greater than about 350Å/sec., this parameter only refers to one aspect of the invention. The Examiner has no basis to confine the applicants to a process of producing a coating at a rate greater than about 350Å/sec. when the written description clearly states applicants' invention relates to a process of producing an "improved coating." Accordingly, the Examiner's reference on page 3 of the June 4 Office Action to the statement in the written description that "the invention is made by CVD rates greater than about 350Å/sec." takes that aspect of the disclosure out of the context of the entire statement of the invention in column 4, lines 13 et seq., and a fair reading of this would show that "CVD rates greater than about 350Å/sec." relate only to one aspect of the invention and the process for producing the improved coating relates to another, i.e., a coating with controlled refractive index, abrasion resistance, color enhancement, low emissivity, selective light filtration, and anti-iridescence. Again, applicants obtain these advantages in producing the improved coating itself, and not by the method of improving production speeds.

The Examiner goes on to state:

Compositional limitations were added in response to Examiner's rejection of the claims as not enabled for the required deposition rates. Examiner's action specifically stated, "The prior art of record fails to teach or suggest a gaseous composition comprising the recited tin oxide precursor, silicon oxide precursor and accelerant selected from borates, phosphates [sic, phosphites] and water". The claims were amended to be limited to those specific materials in response to the rejection. (June 4, 2002 Office Action, p. 3, par. 1).

As to the first contention of the Examiner that applicants added limits to the composition in response to the Examiner's rejection, the Examiner implies that applicants amended the silicon oxide precursors, the tin oxide precursors and the accelerants in response to his rejection relative to the deposition rates. A review of the September 20, 1994 Office Action in the reissue patent and applicants' October 25, 1994 Response will show that the applicants did not do this, but only amended the silicon oxide precursors to obtain allowance. Applicants did not amend the tin oxide, organic phosphite and organic borate accelerants to obtain allowance, nor did the Examiner require these amendments for allowance.

In the September 20, 1994 Office Action in the reissue patent the Examiner rejected claims 1-10, 14-23, 25 and 26 under 35 U.S.C. § 112, first paragraph on the grounds that the disclosure only enabled "claims limited [to] compositions wherein the silicon oxide precursor is limited to that recited in claim 11." (September 20, 1994 Office Action, p. 2, par.1) (emphasis added). The Examiner concluded the rejection on page 2, last paragraph of the September 20, 1994 Office Action by indicating he would allow the claims if applicants rewrote them to overcome the rejection under 35 U.S.C. § 112 and include all of the limitations of claim 11 in the base claim and intervening claims. Applicants' October 25, 1994 Amendment in response to that Office Action

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cancelled claim 11 and inserted the “silicon oxide precursor . . . recited in claim 11” into the claims the Examiner rejected.

Only after the Examiner indicated allowability if the claims were amended to include the silicon oxide precursor recited in claim 11 did he make the statement on page 3 of the September 20, 1994 Office Action that “[t]he prior art of record fails to teach or suggest a gaseous composition comprising the recited tin oxide precursor, silicon oxide precursor and accelerant selected from borates, phosphites and water.” Taking this quotation totally out of context, the Examiner then incorporated it into his June 4 Office Action to argue “[t]he claims were amended to be limited to those specific materials in response to the rejection.” (June 4, 2002, Office Action, p. 3, par. 1). “Those specific materials” would include not only the silicon oxide precursors, but also the tin oxide precursors, and the organic phosphite and organic borate accelerants.

As to this second contention, the Examiner never indicated in the reissue patent he would allow the claims on the condition that the applicants also amend the tin oxide precursor and the accelerant selected from organic borates and organic phosphates. The foregoing analysis of the September 24, 1994 Office Action shows the Examiner’s indication of allowable subject matter in the reissue patent only related to amending the silicon oxide precursor to conform to the claim 11 description of this material. The following analysis of the October 25, 1994 Response also shows that the amendments of the tin oxide precursors, and the organic phosphite and organic borate accelerants were not required for allowance, and were not “limited to those specific materials in response to the rejection.” as the Examiner now contends. In fact, the Examiner never rejected these “specific materials.”

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Applicants in their October 25, 1994 Amendment, not only amended the claims to include the claim 11 definition of the precursors of silicon oxide, but also amended the description of the tin oxide precursors, the organic phosphites and organic borates, even though not required by the Examiner to obtain allowance. Specifically, applicants added new independent claim 27 defining the tin oxide precursor with a generic formula and added claims 28 and 29 relating to a subgenus and a species of the precursor of the tin oxide. The Examiner did not require the generic formula which broadened the tin oxide precursors, or the species of tin oxide precursors for allowance, but he entered these amendments and allowed these claims.

The October 25, 1994 amendment also introduced generic formulas for the organic phosphite and organic borate accelerants of claim 6 and new claim 27, even though not required by the Examiner for allowance of the claims. The Examiner did not suggest these generic formulas which broadened the claims, but he nonetheless entered the amendments and allowed these claims. Claim 24 as originally presented related to a species of an organic phosphite whereas claim 25 as originally filed referred to these accelerants as boron and phosphorous esters. The Examiner did not have any objection to this terminology. New claims 28 and 29 referred to species of organic phosphites and organic borates even though the Examiner did not require an amendment to add these claims which he also allowed.

The foregoing clearly illustrates the Examiner only required one amendment for allowance, and that was for the silicon oxide precursor, which the applicants included in the composition claims of the reissue patent and which applicants also include in process claims 1-27 of the present reissue application.

Any amendments to the tin oxide precursors and the accelerants selected from organic phosphites and organic borates in the reissue patent do not introduce the recapture doctrine into the present application for at least two reasons. In the first instance, and most important, the applicants did not cancel any tin oxide precursor or accelerant selected from organic phosphites and organic borates from any of the claims in the reissue patent, and are not now trying to reintroduce cancelled material by way of this reissue application. In fact they did just the opposite when they amended on October 25, 1994 by adding broadening generic formulas for the tin oxide precursor, and the accelerants as well as species of these materials. Secondly they did not amend the tin oxide precursor, or the accelerants to address a 35 U.S.C. § 112 rejection, a prior art anticipation or obviousness rejection, or any other rejection by the Examiner.

The reissue patent issued with composition claims for a tin oxide precursor and organic phosphite, organic borate, or water accelerants. The present reissue application now introduces process claims for the first time that include metal oxide precursors based on compounds not only of tin, but also germanium, titanium, aluminum, zirconium, zinc, indium, cadmium, hafnium, tungsten, vanadium, chromium, molybdenum, iridium, nickel, and tantalum, and the accelerants including phosphites, borates, water, alkyl phosphine, arsine and borane derivatives, PH<sub>3</sub>, AsH<sub>3</sub>, B<sub>2</sub>H<sub>6</sub>, NF<sub>3</sub>, NO<sub>2</sub>, and CO<sub>2</sub>. The written description supports these compounds at Column 4, lines 13-52.

The Examiner has failed to demonstrate how the amendments to the tin oxide precursors and the organic phosphite and organic borate accelerants in the composition claims of the reissue patent preclude the applicants from claiming any of the foregoing metal oxide precursors and accelerants in the process claims of the reissue application.

Specifically, applicants ask how does the amendment of the tin oxide precursor preclude them from precursors based on, for example germanium where the applicants never stated or indicated in the reissue patent that the invention did not include compounds based on germanium or the other metals listed in the written description at column 4 lines 21-26? The rejection also raises the same question regarding the accelerants.

The Examiner in the June 4 Office Action (p.3, par. 1) cites M.P.E.P. § 1412.01 (penultimate paragraph) as the basis for his argument that the "instant claims are not drawn to the same invention as that disclosed as being the invention in the original patent." That section of the Manual doesn't support the position he takes. It only states that if the "specification" describes a compound (e.g. "compound X") as unsuitable, and after the patent issues the applicants find they can use "compound X," the original disclosure of unsuitability precludes them from obtaining a reissue patent for this compound. The Examiner, however, has not pointed to anything in the written description of the reissue patent or its prosecution history that amounts to a statement by the applicants that they determined or found the metal oxide precursors and the accelerants now claimed in this reissue application unsuitable. Nor can he; the reissue patent, on the contrary, describes each of the presently claimed metal oxide precursors and accelerants as part of the invention. (Written description, col. 4, lines 13-52.)

The written description does describe one aspect of the invention as providing a process and composition for depositing a silicon oxide film at deposition rates greater than about 350Å/sec., and listed several silicon oxide precursor compounds found to provide this deposition rate. (Written description, par. bridging cols. 2-3, and col. 3, first

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full par.). These compounds, however, only comprised the silicon oxide precursors, and not the metal oxide precursors and accelerants.

Applicants' statement about the silicon oxide precursors applied to the composition. Again, as pointed out above in this response, applicants indicated in their written description that the invention not only pertained to the composition, but also to a process for producing an "improved coating" or film. In the discussion of the invention in column 4, lines 13-18 of the written description, applicants separated the process of producing an "improved coating" from the composition and process of depositing the coating at a rate of 350Å/sec. The Examiner has not shown where in the disclosure applicants obtained these "improved coating" features by applying the coating at a rate of 350Å/sec., nor can he, since applicants obtain these advantages in producing the coating or film itself, and not by the method of improving production speeds.

#### Offer in the Alternative to Dedicate Claims to the Public

If, despite the above arguments, the Examiner continues to maintain that claims 28-32 can be rejected on the grounds that applicants have attempted to recapture subject matter that should have entered into the public domain by being previously abandoned in the prosecution of the reissue patent, then applicants, in the alternative traverse the "recapture" rejection by offering to dedicate back to the public, reissue claims 28-32 when and if granted to applicants in this reissue application, and when and if an interference is declared with Neuman et al. U.S. Patents Nos. 5,776,236 ("Neuman '236") and 5,559387 ("Neuman '387"), and Athey et al. U.S. Patent No. 5,356,718 ("Athey"). Applicants, upon being awarded those claims in the interference, will put them back into the public domain by this dedication where they belong if recapture is a valid

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rejection and if applicants were in fact the first inventors and dedicated them to the public through abandonment.

Applicants point out that Neuman '236, Neuman '387, and Athey contain claims to substantially the same subject matter as applicants' claims 28-32. If the Examiner's contention is correct that the subject matter of these claims had been previously abandoned, and by implication dedicated to the public by applicants, then the issuance of these patents have in effect eliminated that so-called dedication, since these patents recaptured that subject matter from the public domain.

Neuman '236, Neuman '387, and Athey were based on patent applications that were either co-pending with the earlier filed reissue patent application or pending at the time the reissue patent issued, and an interference should have been declared between the reissue patent application or reissue patent and the Neuman '236, Neuman '387, and Athey applications or patents. Applicants are willing to provide a way to correct the recapture of subject matter caused by granting Neuman '236, Neuman '387, and Athey by offering to dedicate claims 28-32 to the public upon issuing them to applicants in a reissue patent, and by a declaration of interference between the present application and Neuman '236, Neuman '387, and Athey. When applicants prevail in the interference, a reissue patent containing these claims will be granted, and they will be obligated to dedicate them to the public because of their representation to make the dedication. This will also address the recapture of the subject matter of claims 28-32 that occurred by the issuance of Neuman '236, Neuman '387, and Athey.

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Conclusions

Applicants request the Examiner to withdraw the rejections in view of the foregoing remarks, and issue a Notice of Allowance for all of the claims in this application. If the Examiner withdraws the rejections and allows the pending claims, applicants request that the Examiner indicate in his reasons for allowance, whether it was based upon applicants' arguments, or based upon applicants' alternative offer to dedicate claims 28-32 to the public upon having these claims awarded to them as a result of an interference with Neuman '236, Neuman '387, and Athey.

If entry of this amendment requires an extension of time pursuant to 37 C.F.R. §1.136 and payment of an extension fee or other fee, any of which this amendment fails to account for, applicants' attorneys request such an extension and payment of any fees due from their deposit account 06-0916.

Respectfully submitted,

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